

REMARKS

In the Office Action¹, the Examiner rejected claims 1, 2, 4-9, and 11-15 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,828,374 to Coleman et al. ("Coleman") in view of U.S. Patent No. 6,829,615 to Schirmer et al. ("Schirmer"), U.S. Patent No. 5,714,971 to Shalit et al. ("Shalit"), and U.S. Patent No. 6,262,732 to Coleman et al. ("Coleman II").

By this amendment, Applicant proposes to amend claims 1, 8, and 15. Claims 1, 2, 4-9, and 11-15 are pending.

I. The Rejection of Claims 1, 2, 4-9, and 11-15 under 35 U.S.C. § 103(a)

Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1, 2, 4-9, and 11-15 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]jections on obviousness cannot be sustained with mere conclusory statements."

M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01(III) (emphasis in original). "All

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

words in a claim must be considered in judging the patentability of that claim against the prior art" (emphasis added)." M.P.E.P. § 2143.03. "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Claim 1, for example, recites a computer program product, tangibly embodied in an information carrier, comprising instructions operable to cause data processing apparatus to "receive user input from a user to establish a decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user; and receive navigation input, other than the key used to establish the normal and decoupled modes and distinct from the user input, to navigate from one user interface element to another user interface element."

A. The Individual References Do Not Teach or Suggest the Recitations of the Claims

Coleman discloses a help index that can be searched using an “alpha scroll bar ” (*Coleman*, Fig. 8, and col. 10, line 51 to col. 11, line 14). Letters on the alpha scroll bar can be selected by a number of methods, including “placing [a] cursor over a portion of slider 175, depressing [mouse] switch 46 and dragging the cursor and slider over the desired letter ... [and] releas[ing] [mouse] switch 46,” (*Coleman*, col. 11, lines 20-23) (emphasis added). The final Office Action explicitly relies on *Coleman*’s “depressing” and “releasing” the mouse switch in addressing the user input to establish the claimed normal and a decoupled modes (final Office Action at p. 3).

The final Office Action also relies on *Coleman*’s mouse switch as allegedly corresponding to the claimed navigation input (final Office Action at p. 3). Thus, the final Office Action relies on *Coleman*’s mouse switch when addressing both the claimed “navigation input” and the claimed “user input ... when a key is pressed.” However, independent claim 1 recites that the navigation input is both “distinct from the user input” and “other than the key used to establish the normal and decoupled modes” (emphasis added). Thus, *Coleman*’s mouse switch cannot be relied upon to map to both the claimed “key” and the claimed “navigation input.” For at least this reason, *Coleman* does not teach or suggest at least the claimed “receive user input from a user to establish a decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user; and receive navigation input, other than the key used to establish the normal and decoupled modes and distinct

from the user input, to navigate from one user interface element to another user interface element," as recited by independent claim 1 (emphasis added).

Schirmer discloses a method for managing and presenting information for a group of data objects which can be associated with other data objects (*Schirmer*, abstract). A user can select a data object, and be presented with a number of other data objects that are related to the selected data object (*Schirmer*, col. 6, lines 60-64, and Fig. 1).

The final Office Action contends that *Schirmer's* disclosure of selecting objects corresponds to the claimed "navigation to an independent element with the navigation input is sufficient to cause the independent element to become the selected element" (final Office Action at p. 4). However, to select a data object in *Schirmer*, the user must first navigate to, and then click an object (*Schirmer*, col. 14, lines 27-30). Further, the input device disclosed in *Schirmer* used for "clicking" on the object is a mouse (*Schirmer*, col. 12, lines 13-16). Therefore, *Schirmer's* disclosure uses the same input as disclosed in *Coleman*, i.e., the mouse switch, to receive any "navigation inputs" as alleged by the Examiner. Thus, *Schirmer* also does not teach or suggest the claimed "receive user input from a user to establish a decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user; and receive navigation input, other than the key used to establish the normal and decoupled modes and distinct from the user input, to navigate from one user interface element to another user interface element," as recited by independent claim 1 (emphasis added).

Shalit discloses dragging an object to a "split bar box" which causes a second "pane" to open in a window (*Shalit*, col. 5, lines 5-10). The second pane displays the contents of the dragged object (*Shalit*, col. 5, lines 19-21). The final Office Action alleges that *Shalit*'s dragged object corresponds to the claimed "navigation input ... distinct from the user input" (final Office Action at p. 4). However, as understood by those skilled in the art, objects are conventionally "dragged" using a mouse. Thus, like *Schirmer*, *Shalit* discloses using the same input as disclosed in *Coleman*, i.e., the mouse switch, to act as a "navigation input." Therefore, *Shalit* also does not teach or suggest the claimed "receive user input from a user to establish a decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user; and receive navigation input, other than the key used to establish the normal and decoupled modes and distinct from the user input, to navigate from one user interface element to another user interface element," as recited by independent claim 1 (emphasis added).

Coleman II discloses a "drag and drop" of an object. The Office Action relies on *Coleman II*'s drag and drop of an object as allegedly corresponding to the claimed "decoupled mode when a key is pressed" (final Office Action at p. 4). *Coleman II*, like *Coleman*, discloses using a mouse button to do the drag and drop operation (*Coleman II*, col. 4, lines 1-7). Thus, even assuming the final Office Action accurately describes *Coleman II*, *Coleman II* still does not teach or suggest "receive user input from a user to establish a decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user; and receive navigation

input, other than the key used to establish the normal and decoupled modes and distinct from the user input, to navigate from one user interface element to another user interface element," as recited by independent claim 1 (emphasis added).

B. The References Considered in Combination Do Not Teach or Suggest the Recitations of the Claims

As discussed above, the four cited references each use a mouse switch for varying purposes. The final Office Action relies on *Coleman's* and *Coleman II's* use of a mouse switch when addressing the claimed "user input ... to establish a decoupled mode when a key is pressed," while relying on *Schirmer's* and *Shalit's* use of a mouse switch when addressing the claimed "navigation input." Thus, the Office Action has continually relied upon a single control, i.e. a mouse switch, in addressing the claimed "user input" and "navigation input."

However, Applicants note that the claims, as presented in the Amendment filed September 6, 2007, recited a "navigation input, distinct from the user input" (emphasis added). For this reason, Applicants submit that, independently of the amendments presented herein, the four cited references were never sufficient to establish a prima facie case of obviousness.

Nevertheless, in an effort to expedite prosecution, Applicants have amended the claims herein to recite that the claimed "navigation input" is "other than the key used to establish the normal and decoupled modes." As discussed, the final Office Action relies heavily on the use of a single input, i.e., the mouse switch, in addressing both the

claimed "navigation input" and the claimed "key." For the reasons discussed above, this reliance is improper.

For at least the reasons discussed above, the cited references, alone or in combination, do not teach or suggest "receive user input from a user to establish a decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user; and receive navigation input, other than the key used to establish the normal and decoupled modes and distinct from the user input, to navigate from one user interface element to another user interface element," as recited by independent claim 1 (emphasis added).

C. The Proposed Combination Is Improper

MPEP 2143.01(V) states, "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Here, the proposed modification would necessarily render the references unsatisfactory for their intended purpose.

As discussed, the final Office Action relies on a single input, e.g. a mouse switch, in addressing a number of different recitations of the claims. In doing so, the final Office Action effectively overloads the use of the mouse switch in a manner inconsistent with the teachings of the applied references. For example, if the mouse switch is used to drag and drop objects as in *Coleman II* or *Shalit*, the mouse switch cannot concurrently be used to select letters on an alpha scroll bar as in *Coleman*. Further, even assuming a mouse switch could be modified to both drag and drop objects and select letters on an

alpha scroll bar, the mouse switch could not also be used to select a data object to see related data, as disclosed in *Schirmer*.

For the reasons discussed above, the proposed combination would overload the functionality of the mouse switch in manner not disclosed or suggested by the cited references. Further, even assuming a mouse switch could be modified as would be required to combine the references, the Examiner has provided no explanation of how such a modification could be achieved. Therefore, the proposed combination would render the cited references unsuitable for their intended purposes, and there is no suggestion or motivation for the proposed combination.

D. Conclusion

As outlined above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Furthermore, the Office Action has failed to provide a motivation to combine *Coleman II* with the other applied references. Accordingly, the Office Action has failed to clearly articulate a reason why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1, as well as for claims 2 and 4-7 depending therefrom

Although of different scope, independent claims 8 and 15 recite elements similar to those of claim 1 already discussed. Therefore, Applicant respectfully requests withdrawal of the rejection of independent claims 8 and 15 under 35 U.S.C. § 103(a), as

well as dependent claims 9 and 11-14 at least for the reasons discussed with respect to claim 1.

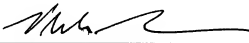
In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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